

REMARKS

Claims 1-24 and 38-50 are pending in the application, claims 25-37 being canceled and claims 39-50 being newly added herein. Claims 1, 38, 39, and 47 are the only independent claims.

Specification

Pursuant to a requirement made by the Examiner, the title is amended herein to be indicative of the invention to which the claims are directed. The amended title indicates that a loop has indentations for use of the loop in different sizes.

Also, a typographical error on page 11, line 19, has been corrected, pursuant to the Examiner's observation.

Information Disclosure Statement

The Examiner has pointed out that the listing of references in the specification is not a proper information disclosure statement. The references referred to by the Examiner have been listed on a citation form submitted since the issuance of the Office Action of June 14, 2005.

Drawings

The drawings were objected to as failing to comply with 37 C.F.R. 1.84(p)(5) because they do not include the following reference signs mentioned in the description: reference numeral 21, page 8, line 12; reference numeral 16, page 9, line 1.

In partial response to the objection to the drawings, applicant encloses herewith a replacement sheet for Figures 2 and 3, showing the reference numeral 21 in both those figures. Also enclosed is an annotated copy of that sheet of drawings, showing the addition of the reference numeral in red ink.

In further response to the objection to the drawings, applicant has amended the specification at page 9, line 1, to change the reference numeral "16" to "18" which is consistent with the remainder of the specification.

Claims Rejections - 35 U.S.C. § 112

Claim 20 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner does not specifically point out the deficiency in the language of claim 20.

Applicant nevertheless amends claim 20 herein to make the language formally more consistent with traditional meaning, particularly of the word "bend".

Claims Rejections - 35 U.S.C. §§ 102 and 103

Claims 1-7, 10-13, 16-23, 25-27, and 30-37 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,752,961 to Hill

Claims 8, 9, 14, 15, 24 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hill in view of U.S. Patent No. 5,759,187 to Nakao et al.

The Invention The clinical importance of the present invention is that it provides two snares instead of one in a single device. In this time of great sensitivity to price pertaining to disposable devices, this invention is very important in that it allows cost savings for a procedure that requires differently sized snares: Applicant's snare precludes the need to use two differently sized snares in the same procedure, thus contaminating two disposable instruments instead of one. Owing to the present invention, a hospital needs to stock only half as many snares and use half as many snares in a colonoscopy where multiple polyps of different sizes are found. This cost savings affects the hospital, and, of course, is carried over to the patient. Furthermore, when

only one snare needs to be used, time is saved in eliminating the need to exchange instruments, thus shortening the procedure, and thus the discomfort, and risk to the patient. Applicant believes that these advantages are very important and therefore respectfully asks the examiner to consider these during his second review of the application.

Claim 1 Claim 1 has been amended herein to include a limitation, from claim 11, that clearly distinguishes over the reference relied on by the Examiner. To the extent that the rejection of claim 11 may be considered applicable to amended claim 1, applicant respectfully traverses the Examiner's rejection of claim 11 and maintains that claim 1 is patentable over the prior art.

As set forth in amended claim 1, a medical instrument comprises a tubular member, an elongate member disposed at least partially inside the tubular member, and a resilient loop having a substantially planar fully expanded configuration of a first size attached to one end of the elongate member. The loop includes a bend on a side of the loop opposite the elongate member and further includes two loop sections each extending between the elongate member and the bend. At least one of the loop sections is formed with at least one notch or dent for enabling a use of the loop in at least one second size smaller than the first size upon a positioning of the loop by moving the elongate member and the tubular member relative to one another so that the notch or dent is disposed at a mouth opening of the tubular member.

Hill discloses an angled snare assembly which assumes a complex three-dimensional configuration that is clearly not planar, especially in its fully expanded configuration. There is no way that one of ordinary skill in the art could reform the snare of Hill, without radically departing from the principles and objectives of the Hill invention.

Claim 39 New Independent claim 39 includes the limitations of original claim 1, as well as a limitation from original claim 10. To the extent that the Examiner's rejection of claim 10 could be applied to new claim 39, applicant respectfully traverses the rejection of claim 10 and contends that claim 39 defines patentable subject matter.

As set forth in new claim 39, a medical instrument comprises a tubular member, an elongate member disposed at least partially inside the tubular member, and a resilient loop of a first size attached to one end of the elongate member. The loop includes a bend on a side of the loop opposite the elongate member and further includes two loop sections each extending between the elongate member and the bend. At least one of the loop sections is formed with at least one notch or dent for enabling a use of the loop in at least one second size smaller than the first size upon a positioning of the loop by moving the elongate member and the tubular member relative to one another so that the notch or dent is disposed at a mouth opening of the tubular member. The notch or dent in the one loop section extends toward the other loop section.

To the extent that any of the bends in a section of the Hill snare might be interpretable as notches or dents, those bends define outwardly extending formations, not formations that extend towards another section of the Hill loop or snare. The only bends in the Hill loop that extend inwardly (possibly towards a section of the loop) are two (26) that partially define a nose projection at the very distal end of the snare. Those bends, however, cannot possibly function in the manner set forth in claim 39 inasmuch as those bends cannot enable a use of the loop in a small size. Those bends of the Hill loop are just too distal to serve as notches or dents pursuant to applicant's claim 39.

Claim 47 New claim 47 is the same as original claim 1, but with a simple change in terminology that clarifies applicant's invention. The term "notch or dent" in claim 1 has been

replaced with the term “indentation or dimple”. This new terminology is believed to more clearly distinguish applicant’s invention over the prior art and particularly over the Hill reference, because the term “indentation or dimple” denotes local deformations in the loop (18) that do not affect the overall shape of the loop or the directions of the loop sections (28 and 30).

The bends (24, 28, 30, and 32) in the Hill loop are not indentations or dimples. The bends (24, 28, 30, and 32) in the Hill loop are not local deformations; each of them gives rise to a change in direction or orientation in the loop.

Applicant’s indentations or dimples are small features in relation to the overall size of the loop. That is the meaning of the term “indentation or dimple”. In contrast, the bends of Hill result in changes of direction or orientation that affect the overall shape of the Hill loop.

Claim 38 Method claim 38 has been amended to incorporate several of the limitations discussed above with reference to the apparatus claims. Claim 38 now recites that the resilient loop has a planar configuration and that a loop section has an indentation or dimple extending inside the loop toward another loop section.

Claim 38 distinguishes over the Hill reference for reasons discussed hereinabove.

Information Disclosure Statement Pursuant to the Duty to Disclose under 37 C.F.R. §1.56(a), applicant transmitted, to the Patent and Trademark Office by mail certificate dated July 25, 2005, a copy of an Information Citation Form (Form PTO-1449) listing patent documents relevant to the background of the invention described and claimed in the above-identified application. Enclosed is a copy of that Information Disclosure Citation.

The Information Disclosure Statement accompanying the form did not contain a certification pursuant to 37 C.F.R. § 1.97. Accordingly, Applicant encloses herewith a check in

the amount of One-Hundred-and-Eighty Dollars (\$180) in payment of the fee for late filing of an Information Disclosure Statement.

The claim amendments, if any, made herein are made without prejudice to applicants' right to pursue additional subject matter in a separate continuation or divisional application.

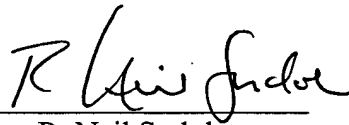
Conclusion

For the foregoing reasons, independent claims 1, 38, 39, and 47, as well as the claims dependent therefrom, are deemed to be in condition for allowance. An early Notice to that effect is earnestly solicited.

Should the Examiner believe that direct contact with applicant's attorney would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the number below.

Respectfully submitted,

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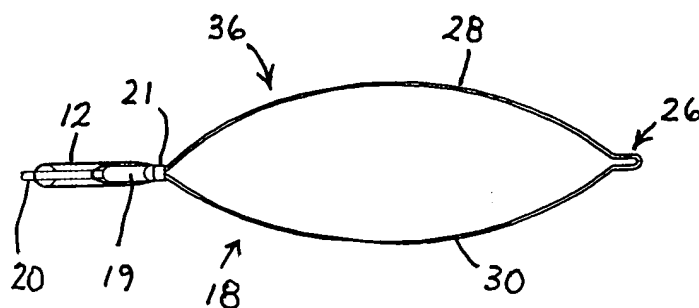


FIG. 3